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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,002	11/01/1999	HADI PARTOVI	22379-702	8108

7590

02/21/2003

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EXAMINER

THOMPSON, MARC D

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 02/21/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/431,002

Applicant(s)

PARTOVI et al.

Examiner

Marc Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 12, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Nov 1, 1999 is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This application has been reassigned to a new Examiner. See **Conclusion** section below, for new Examiner contact information.
2. Amendment A, Paper #14, received 12/12/2002, has been entered into record.
3. Claims 1-25 remain pending.

Priority

4. This application is a continuation-in-part of parent 09/426,102, filed 10/22/1999.
5. The effective filing date for the subject matter defined in the pending claims which has support in parent 12/12/2002 in this application is 10/22/1999. Any new subject matter defined in the claims not previously disclosed in parent 09/426,102, is entitled to the effective filing date of 11/1/1999.

Information Disclosure Statement

6. Examiner notes multiple IDS papers entered previously into record, namely Paper numbers 3, 4, 5, 7, 11, and 12, filed 12/2/1999, 12/27/1999, 1/19/2000, 7/18/2000, 3/27/2001, and 6/26/2001, respectively. Many of these IDS statements contain(ed) duplicate entries, and all have been considered by the previous Examiner. It is unclear to the current Examiner which IDS statements were supplied to Applicant with the last Office action, Paper #13. If Applicant failed to receive any of these considered IDS documents, Applicant is invited to contact the current Examiner for verification, further clarification, or copies of the IDS statements.

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Drawings

7. The Examiner contends that this application has been filed with drawings which are acceptable for examination purposes.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-10, 13-17, 19, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wise et al. (U.S. Patent No. 5,884,262), hereinafter referred to as Wise, in view of Didcock (U.S. Patent No. 6,396,907), hereinafter referred to as Didcock, further in view of Kamel et al. (U.S. Patent Number 5,937,037), hereinafter referred to as Kamel.

Regarding claims 1 and 25, Wise teaches a method of providing content from the Internet to a telephone using a computer system. See Column 1, Line 66 through Column 2, Line 2. The computer system included a telephone interface system coupled with an Internet access system,

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and a standard telephone. See Figure 1, hardware (100), Column 5, Lines 35-42, telephony board (111), computer network (15), and standard telephone (10). Wise further taught receiving an Internet access request, the Internet access request corresponding to an Internet site outside of the computer system, receiving the content from the Internet site, which included an audio portion, and sending at least the audio portion of the content over the telephone interface system to send an audio signal, corresponding to the audio portion, to the telephone. See Column 2, Lines 5-16.

Wise taught the invention substantially as claimed, however, Wise did not expressly teach streaming content, or any specifics related directly to implicit request/response generation from the computer network entities. Also, Wise expressly provided the provision for user profiles and storage of user preferences. See Column 3, Lines 9-18. Although Wise disclosed the invention substantially as claimed, Wise remained silent as to how the specifics of a given profile were used in combination with the user experience using the network. An artisan would have been motivated to search for details involving inclusion of profile information for decision making. Further, an artisan working with the Wise system would have also been motivated to search the related arts for two inherent features of a network of this type, namely information transport, and billing for network usage. These two features were only a small portion of inherent concerns network computer artisans would have been motivated to explore, since Wise did not directly address such details in the description of the invention.

Didcock discloses streaming as a well-known technique for delivering pace-content information across a network. See Didcock, Column 1, Lines 27-29. Thus, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wise with the streaming content of Didcock because it permitted access to an internet by people with special needs, e.g., the visually impaired, while the system provided telephone based voice messaging independent of the speed of the links coupling users' computers to the network. See Didcock, Column 2, Lines 6-9, and Column 3, Lines 29-34. Further, since the Wise system utilized network information transport, specifically audio, and Didcock dealt directly with maintaining quality of service when utilizing the network for audio reception (Column 1, Line 58 through Column 2, Line 9), incorporating the teachings of Didcock into the system of Wise would have been obvious to one of ordinary skill in the art at the time the invention was made.

Further, in the same art of network/Internet telephony, Kamel provided a method for targeting user clients of the network with advertisements and promotional messages to groups and individuals based on the contents of the messages and particular user/group profiles. See Column 1, Lines 57-62. The system allowed user clients to build credit(s) for use of the network system by interacting with the promotional advertisements. See Column 4, Lines 36-49. The system was also implementable in a system using particular subscribers and associated voice/data mailboxes. See Column 4, Lines 50-65. Thus, an arbitrary user of the network would have been required to interact with the message(s) in order to use the system for telephony. See Column 4, Lines 36-49. This would have provided an ordinary artisan with minimal requisites to ensure use

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of the network system was not at the expense of those not using the network for information transport.

Kamel disclosed “[receiving an] Internet access request implicitly based on at least one user personalization choice...”, as claimed. By allowing a user to request a connection with a remote device (e.g., telephone), where the calling user then received promotional information or an advertisement, implicitly, i.e., the user did not ask for the advertisement, selected and delivered to the user based on the user profile. See Column 1, Line 57 through Column 2, Line 10, Column 5, Lines 27-42, and Column 24, Lines 43-67. Indeed, this system was completely compatible with a voice message network application, accessible through an internet server. See Column 4, Lines 52-55, and Column 11, Lines 32-36. This system further selected messages for streaming to end user equipment before (Column 24, Lines 43-54), during (Column 25, Lines 8-12), and after (Column 26, Lines 13-15), the call was initiated. Thus, in many of these embodiments, when a user accesses the system, s/he was presented with streaming, Internet originated, audio information, without making a single explicit request. Thus, the provision for implicit requests based on user profile entries was fully disclosed by Kamel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephony system of Wise and Didcock with the telephony methodology of Kamel, in order to ensure compensation for use of the network services. The associated teachings of Kamel also additionally included the “filtering” and determination of “relevant” content to user(s) based on their profile entries, commensurate with the general teachings of Wise

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at Column 1, Line 37 through Column 2, Line 17, and generalized inclusion of modular functionality set forth in Column 4, Lines 17 through Column 5, Line 28.

Regarding claim 2, Wise further taught wherein receiving the Internet access request comprises receiving a verbal request (Column 2, Lines 5-7) to access the Internet site and performing voice recognition (Column 2, Lines 7-8 & Line 50) on the verbal request to determine the Internet access request.

Regarding claim 3, Wise further taught receiving the Internet access request comprises: receiving a series of one or more touch tone signals (DTMF, Column 2, Lines 5-7) and decoding the series of one or more touch tone signals (Column 2, Lines 7-8) to determine the Internet access request.

Regarding claim 4, Wise further taught providing a menu corresponding to accessible Internet sites, and wherein the receiving the Internet access request corresponds to receiving a selection from the menu (Column 2, Lines 25-26).

Regarding claim 5, Wise further taught determining the type of streaming content and converting the corresponding type of streaming content into an audio portion (Column 2, Lines 11-15).

Regarding claim 6, Wise further taught the Internet access system includes a web server, wherein the web server connects to the Internet site to receive the streaming content (Column 8, Lines 44-45).

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Regarding claim 7, Wise further taught the streaming content was received as packet data (Column 9, Lines 47-50) from a packet switched network and wherein the telephone interface system communicates the audio signal (Column 9, Lines 47-50; Wise discloses a standard analog telephone which inherently communicates over the PSTN) to a Public Switched Telephone Network (PSTN).

Regarding claim 8, Wise teaches a URL relating to a verbal phrase (Column 6, Lines 46-49). In the computing networking arts, a universal/unique resource locator (URL) and a universal/unique resource identifier (URI), are logically identical. A URL which specifies a particular network location, is a URI, i.e., a unique identifier which points to a particular network resource.

Regarding claim 9, Wise further taught computer system includes personalized content information (Column 3, Lines 10-13) and wherein the Internet access request is generated (Column 3, Lines 15-16) from the personalized content information.

Regarding claim 10, Didcock further taught the computer system further comprises a local streaming content system (Didcock, Figure 2, stream management unit 222), the local streaming content system including a second streaming content (Column 2, Lines 40-43), the second streaming content including at least a second audio portion (Data blocks; Column 2, Lines 43-46 & Lines 58-59), and wherein the method further comprises accessing the local streaming content system to provide a second audio signal corresponding to the second audio portion to the telephone (Column 2, Lines 58-62).

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Regarding claim 13, Didcock further taught an audio repository (LTSR; Column 2, Lines 37-39), wherein the method further comprises accessing the audio content from the repository to provide to the telephone (Column 2, Lines 61-62).

Regarding claim 14, Didcock further taught receiving a command (Column 5, Lines 65-67), the command corresponding to a request by the telephone user to adjust the sending of the audio portion (pause command; Column 6, Lines 1-2), and adjusting the sending of the audio portion (Column 10, Lines 6-8).

Regarding claim 15, Wise and Didcock further taught commands corresponding to a pause command (Didcock, Column 6, Line 2), and wherein the sending the audio portion is paused and wherein a pause command is sent out to the Internet site (Wise, Column 2, Lines 25-26).

Regarding claim 16, Didcock further taught the command corresponds to a pause command (Didcock, Column 6, Line 2), and wherein the sending the audio portion is paused and wherein at least the audio portion of the streaming content is cached during the pause (Didcock Column 10, Lines 5-8 & Column 2, Lines 38-40).

Regarding claim 17, the combined system of Wise, Didcock, and Kamel taught a computer system to deliver streaming content (Didcock, Column 1, Lines 27-29) from the Internet to a telephone, the computer system comprising:

an Internet interface including at least one program (parser; Wise, Column 6, Line 40) to receive the streaming content in response to an implicit request based on at least one user

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personalization choice from the Internet and extract a streaming audio signal from the streaming content (Wise, Column 5, Lines 66-67, and Kamel, Column 1, Line 57 through Column 2, Line 10, Column 4, Lines 52-55, Column 5, Lines 27-42, Column 11, Lines 32-36, and Column 24, Lines 43-67).

a telephone interface to send an audio signal to the telephone, the audio signal corresponding to the streaming audio signal (Wise, Column 6, Lines 1-2 & 7-8); and a control subsystem to control the Internet interface and the telephone interface (Wise, Column 5, Lines 33-35).

Regarding claim 24, Wise further taught the telephone interface subsystem includes a call manager (Figure 2, call manager 210), the call manager supporting multiple simultaneous telephone calls over the telephone interface, at least one of the telephone calls receiving the streaming audio signal. While Wise did not explicitly teach multiple simultaneous telephone calls, Didcock taught simultaneous audio streams (Column 5, Line 24). Previously made OFFICIAL NOTICE regarding the change in the number of calls as a design consideration as known to one with ordinary skill in the art, is hereby treated as Applicant admitted prior art for the remainder of prosecution. See MPEP § 2144.03.

Thus, since all the claimed invention limitations were expressly set forth by the combination of Wise, Didcock, and Kamel, claims 1-10, 13-17, 19, and 24-25 are rejected.

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11. Claims 11, 12, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wise, Didcock, and Kamel, as applied to claim 10 above, further in view of Billings et al. (U.S. Patent Number 6,115,747), hereinafter referred to as Billings.

Regarding claim 11, the combination of Wise, Didcock, and Kamel taught the invention substantially as claimed as detailed above. The combination did not teach mixing (merging/multiplexing, etc.) the audio portion with the second audio portion and wherein the audio signal corresponds to the mix. However, in the same art of information retrieval with data streams, Billings taught merged data packets to form a combined stream (Column 4, Lines 26-28). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wise, Didcock, and Kamel with the combined stream of Billings because it allows content delivery to be optimized for a particular users' retrieval needs.

Regarding claim 12, Didcock and Billings further taught an audio repository (Didcock, LTSR, Column 2, Lines 37-39), wherein the method further comprises accessing the audio content from the repository to provide to the telephone (Didcock, Column 2, Lines 61-62), and mixing the audio portion with the second audio portion and the audio content (Billings, Column 4, Lines 26-28).

Regarding claims 18-20, Didcock and Billings further taught an audio repository (Didcock, LTSR, Column 2, Lines 37-39) storing audio storing sounds, and the computer system

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included a second program (Billings, merging processor, Column 9, Lines 29-31) causing at least some sounds to be mixed with the streaming audio signal (Billings, Column 4, Lines 26-28).

Regarding claim 21, Kamel taught delivering promotional messages to telephone subscribers via telephone networks (Kamel, Column 1, Lines 9-11 & Lines 59-60).

Regarding claim 22, Kamel further taught personal preference information and wherein the advertisement is chosen based at least partially upon the personal preference information (Kamel, Column 1, Lines 9-11).

Regarding claim 23, Wise further taught where at least one sound is a system prompt (Wise, Column 9, Lines 7-8).

Response to Arguments

12. Applicant's arguments filed have been fully considered but they are not persuasive. Applicant argues one specific feature of the claimed invention which alleges to distinguish the currently claimed invention from the prior art of record.

a. Applicant argues the prior art of record did not expressly disclose a method for providing streaming content to a telephone in response to an implicit request based on a user personalization choice. This directly equated to selection and reception of (network retrieved) information not specifically asked for by the user. Further, this selection of information was based on an arbitrary user "personalization" choice, e.g., an entry in the user profile. In Applicant's words, "as such, [chosen/relevant] streaming content can be provided to a user without the user explicitly requesting the content." See Response, Paper #14, Page 6,

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Lines 20-21. It should be clear that Kamel disclosed this express functionality, by allowing a user to request a connection with a remote device (e.g., telephone), where the calling user then received promotional information or an advertisement, implicitly, i.e., the user did not ask for the advertisement, and it was selected based on the user profile. See Column 1, Line 57 through Column 2, Line 10, Column 5, Lines 27-42, and Column 24, Lines 43-67. Indeed, this system was completely compatible with a voice message network application, accessible through an internet server. See Column 4, Lines 52-55, and Column 11, Lines 32-36. This system further selected messages for streaming to end user equipment before (Column 24, Lines 43-54), during (Column 25, Lines 8-12), and after (Column 26, Lines 13-15), the call was initiated. Thus, in many of these embodiments, when a user accesses the system, s/he was presented with streaming, Internet originated, audio information, without making a single explicit request.

b. It is noted that Applicant did not properly respond to the last Office Action by failing to address the teachings of Kamel, as previously applied. All other rejections, not relying on Kamel, were addressed. Claims 21 and 22 were previously rejected using the combination of Wise, Didcock, Billings, and Kamel. Failure of applicant to distinguish over this piece of art, including all the others cited and applied, fails to place this application and the current claims in condition for allowance.

c. Further, the breadth of the claims may construe storage of a particular flag, or value, in a user profile, which resulted in automatic retrieval and presentation (implicitly requested) of a particular greeting or announcement. Wise brushed on this functionality, inter alia, in Column 1,

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Lines 25-36. This type of customized greeting and specialized announcement(s) based upon user profile entries has been utilized in computer networks for decades. For example, a simple script file was activated upon "login" to a network, wherein one of contained entries pointed to an audio file at a remote site (e.g., AOL's "You have mail."). This would meet claim 1, as amended.

d. It should be noted that nothing in a computer system is/was expressly "implicit". Computers only do exactly what they are told, i.e., computers are/were programmed with specific functionality which dictated proper action response based on computer state(s). Computers are inherently state machines, i.e., computers are always in a particular state. Based on the state(s) of the computer/system/ component(s), the computer(s) were instructed to change state. Nothing thus far indicates any implicit decision making. In fact, it is well known in the art that a computer which failed to follow instructions explicitly, resulting in an improper state, is denoted "crashed", since the machine has misinterpreted or misexecuted explicit instructions. As interpreted by the Examiner, "...request implicitly based on..." related directly to client request(s) processed by the system which were not directly made by the client. A typical example at the time of invention was a standard HTML document, containing embedded images. The document contains addresses of images for presentation, images reside somewhere on the network, and the client browser or responding server retrieves the image information implicitly, since none of the individual images were specified in the initial HTML GET request. Thus, direct clarification and

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definition of "implicitly" as used in the claims and as known in the art is required to distinguish over the prior art of record.

e. Any "implicitly" generated request (as opposed to an explicitly generated request) can reasonably be considered an automation of a manual activity, i.e., automatically generating a secondary/new request based on an actual (or lack of) explicit request made by a network user, or simply eliminating any/all explicit request(s). The Examiner does not consider this to constitute a step of invention. See MPEP § 2144.04 (II) and (III).

f. The inclusion of streaming information as a suitable network transport would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the notoriously widely known and widely implementation of information streaming for timely network transport of digital information. Examiner takes Official Notice (see MPEP 2144.03) that "streaming" in a computer networking environment was well known in the art at the time the invention was made, as exemplified by several of the patents cited as relevant for this application. The Applicant is entitled to traverse the official notice according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did

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not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

g. As noted above, previous taking of OFFICIAL NOTICE regarding the change in the number of calls as a design consideration as known to one with ordinary skill in the art, is hereby treated as Applicant admitted prior art for the remainder of prosecution. See MPEP § 2144.03.

13. Lastly, Applicant's arguments with respect to the pending claims have been considered, but are considered moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750.

The Examiner can normally be reached on Monday-Friday from 9am to 4pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Powell, can be reached at (703) 305-9703.

The fax phone numbers for the organization where this application is assigned are as follows:

(703) 746-7238	(After Final Communications only)
(703) 746-7239	(Official Communications)
(703) 746-7240	(for Official Status Inquiries, Draft Communications only)
(703) 746-5487	(for informal communications directed to the Examiner)

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900, or Customer Service for Technology Center 2100 at (703) 306-5631.

MARC THOMPSON
Marc D. Thompson
Patent Examiner
Art Unit 2142